

### **REMARKS**

These amendments and remarks are filed in response to the Office Action dated September 30, 2009 (the "Office Action"). Although no fees are believed to be due, authorization is given to charge any necessary fees to Deposit Account No. 50-0951. At the time of the Office Action, claims 1-20 and 22 were pending. Claim 21 was cancelled. No claims were allowed. The objections, rejections and responses thereto are set out in full below. No new matter has been added.

#### **I. Rejections Under 35 U.S.C. § 101**

Claims 1-20 and 22 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants have herewith amended claims 1, 9 and 10 to tie the method to a particular machine. Claim 14 has been amended to be more in line with traditional beauregard claims. Accordingly, all independent claims are believed to be directed to statutory subject matter. The dependent claims are believed to be directed to statutory subject matter due to their dependence on a base claim that is directed to statutory subject matter and due to further features recited therein. Withdrawal of the rejection is respectfully requested.

#### **II. Rejections Under 35 U.S.C. § 103**

Claims 1-19 and 22 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent Application Publication No. 2004/0128356 to Bernstein et al ("Bernstein") in view of U.S. Patent Application Publication No. 2003/0229670 to Beyda ("Beyda") and U.S. Patent No. 7,406,501 to Szeto et al ("Szeto"). Claim 20 was rejected under 35 U.S.C. § 103 as being unpatentable over Bernstein in view of Beyda and Szeto and further in view of U.S. Patent Application Publication No. 2002/0065894 to Dalal et al ("Dalal").

Although Applicants respectfully disagree with the rejections, Applicants have amended the claims. Accordingly, prior to addressing the cited references, a brief review of the amended claims is appropriate.

##### **A. Review of Amendments to the Claims**

Independent claim 1 has been amended to recite, *inter alia*, determining, with an instant messaging client and utilizing a processor that is executing the instant messaging

client, an Internet presence of a contact identified in an email message in response to displaying the email message to a user, wherein the determining comprises comparing an email address of the contact identified to an address book database and retrieving an instant messaging address of the contact identified from the address book database and then using the retrieved instant messaging address to determine that the contact is present at the time that the email message is displayed to the user. Independent claims 9, 10 and 14 have been similarly amended. Support for such amendments can be found at least at paragraph [0136] from Applicants' published application (United States Patent Application Publication No. 2004/0078448). No new matter is added.

B. Comparison to the Cited References

Bernstein, Beyda, Szeto and/or Dalal fail to disclose, suggest, or render obvious determining, with an instant messaging client, an Internet presence of a contact identified in an email message in response to displaying the email message to a user, wherein the determining comprises comparing an email address of the contact identified to an address book database and retrieving an instant messaging address of the contact identified from the address book database and then using the retrieved instant messaging address to determine that the contact is present at the time that the email message is displayed to the user. In fact, at least Bernstein specifically teaches against such a claimed arrangement.

The Office Action cited to page 7, ¶¶ [0124]-[0131] of Bernstein to support the rejection. Bernstein, however, specifically discloses that “[u]pon receiving this client request 1152, the server preferably checks the database 150 to see if it recognizes any Instant Messaging sessions 130 with that particular ID 132.” Bernstein, ¶ [0129] (emphasis added). This paragraph cited by the Office Action clearly states that the server (*i.e.*, not the client) checks the database. In this regard, Bernstein fails to teach the claimed subject matter.

Still further, Bernstein's focus on the server teaches against the claimed subject matter utilizing the instant messaging client. For instance, Bernstein specifically teaches away from using client software for instant messaging by noting the problems with such clients in the background section. Bernstein indicated as follows:

[0010] Lack of interoperability causes a significant problem. Each Instant Messaging service provider only supports its own Instant Messaging protocol

and client software. Clients from one Instant Messaging service provider, using that service provider's Instant Messaging software can typically only communicate with other people who use the same service provider and software. A person cannot arbitrarily send an Instant Message to another person, unless that other person uses the same Instant Messaging service provider and software that they do. For example, "Joe" uses AOL's Instant Messenger, and "Jane" uses Yahoo's Messenger. Even if Joe and Jane know each other's screen names, they cannot communicate with each other since they are using different Instant Messaging service providers.

Bernstein, ¶ [0010]. In this regard, Bernstein teaches against utilizing the client for any instant messaging.

Bernstein also does not disclose, suggest or render obvious determining that the contact is present in response to displaying the email message to a user and at the time that the email message is displayed to the user. The cited portion of Bernstein actually does not teach any determination regarding the presence of the contact/sender of the original email, much less determining that the contact is present in response to displaying the email message to a user and at the time that the email message is displayed to the user.

With reference to the paragraphs cited by the Office Action, Bernstein discloses as follows:

An email is sent and stored in the server-side database 150 in ¶[0125] (“If an email is sent in the first method, the email body is sent by the client browser code up to the server computer 110. Server computer 110 then may preferably store this email message in the server-side database 150, allowing for future retrieval via URL”). If the recipient of that email chooses to respond via instant message, the message is sent back to the server computer 110. Bernstein, ¶ [0128]. “Upon receiving this client request 1152, the server preferably checks the database 150 to see if it recognizes any Instant Messaging sessions 130 with that particular ID 132.” Bernstein, ¶ [0129]. Thus far, presence information has not been determined—reference to particular ID 132 does not determine presence.

Bernstein stated the following with respect to *ID 132*:

[0099] This is a simple matter for server 100 to do, since each and every Instant Messaging 130 has a unique ID 132. Communication 142 between users 200, 300, and 400 must pass through the server 100 prior to delivery and is uniquely bound to its Instant Messaging session 130 via a unique ID 132.

[0100] This is a powerful feature, in that the URL contained in the email initiating the whole Instant Messaging session 130 always contains that unique ID 132. The user whenever looking at that email at any time in the future, will trigger the server 100 to attempt fetching all the Instant Messaging messages 168 has stored for that email. The email will then continue to display to the user the complete Instant Messaging transcript associated with the email.

Bernstein, ¶¶ [0199] and [0100].

Thus, ID 132 refers to *saved* instant messaging sessions. ID 132 does not identify any presence information. After checking for a particular ID 132, Bernstein “preferably associates this message 142 with that unique ID, and stores it in the server-side database in some form 168. This approach allows the system to operate on virtually any hardware platform, operate through firewalls, etc.” Bernstein, ¶¶ [0130]. In this regard, Bernstein actually reiterates the saving of messages again. Paragraph [0131] does not mention anything regarding determining presence information.

In summary, Bernstein teaches that when a user responds with an instant message, only the unique ID 132 is checked to associate the responsive message with previously saved initiating message. With the system of Bernstein, there is no correlation between the time a user sends an email and the time a recipient reviews the email and responds. Merely sending an email does not guarantee that the recipient will receive it when the sender is still present for instant messaging. There is absolutely nothing to suggest determining that the contact is present in response to displaying the email message to a user and at the time that the email message is displayed to the user.

Beyda, Szeto and/or Dalal fail make up for the deficiencies and explicit teaching away of Bernstein. Accordingly, withdrawal all obviousness rejections is respectfully requested.

### **III. Conclusion**

For at least the reasons set forth above, the independent claims are believed to allowable. The dependent claims are believed to be allowable due to their dependent on an allowable base claim and due to further features recited therein.

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The currently pending claims are supported throughout the specification and are patentable over the prior art. This application is now in full condition for allowance, and such action is respectfully requested. The examiner is cordially invited to call the undersigned if clarification is needed on any matter within this amendment, or if the examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

**AKERMAN SENTERFITT**

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